

REMARKS

A. Examiner Interview Summary

In March 2009, Applicants representative, Mark Garrett, exchanged emails with Examiner Ark about the current rejections. Mr. Garrett proposed amending claim 11 to recite that the bait station comprises both a base and a lid in order to distinguish the Johnson reference, and to recite placing bait in the bait station, as proposed by the Examiner. Mr. Garrett explained that it was not appropriate to modify Crossen as the Examiner proposed. The Examiner proposed several additional amendments in his March 25, 2009 4:44 PM email. In the most recent exchange, when asked whether Mr. Garrett's explanation of why "Crossen is simply not a suitable reference to modify as proposed" made sense, the Examiner responded that "[i]t make sense, but I am not persuaded to allow the case based on the arguments [and claim amendments] you have presented" The email exchanges are attached to this response.

B. Claim 11 Is Novel over Johnson.

Claim 11 stands rejected as anticipated by Johnson (US 6,807,768). While Applicant does not acquiesce to the Office's reading of this claim on Johnson, in an effort to expedite prosecution, claim 11 has been amended to recite "providing a plastic bait station comprising a lid and a base, the base having a bottom in which openings are positioned" (the underlined words having been added). While Johnson has a bait station comprising a lid and a base (see col. 2, lines 40-41: "The bait station **20** has two components, a base **22** and a detachable lid **24**.")), Johnson does not disclose or suggest a receptacle configured to hold weighted material. Accordingly, the rejection has been overcome and should be withdrawn.

C. Claims 11 and 12 Are Patentable over Crossen.

Claims 11 and 12 stand rejected as obvious over Crossen (US 6,513,283). Claim 11 is directed to a method for securing a bait station, and the method comprises:

providing a plastic bait station comprising a lid and a base, the base having a bottom in which openings are positioned;

providing a receptacle configured to hold weighted material, the receptacle having protrusions respectively configured to extend through the openings in the bottom of the base of the plastic bait station;

placing pre-formed weighted material in the receptacle;

placing bait in the plastic bait station; and

securing the plastic bait station to the receptacle, the securing including causing the protrusions of the receptacle to extend through the openings in the bottom of the base of the plastic bait station.

The Office contends that Crossen's weight 120 meets the "receptacle configured to hold weight material" recited in the providing step, and that center section 123 of weight 120 meets the "pre-formed weighted material" that is placed in weight 120. Applicant respectfully traverses.

Crossen states that "weight **120** is made from recycled rubber The weight **120** has a . . . center section **123** that is harder/more dense than the periphery of the weight **120**. This centrally disposed solid section **123** is the portion of the weight **120** where the bait station **128** is anchored to the weight the solid section **123** centralizes the weight distribution of the weight **120** which vastly improves the anchoring characteristics of the weight **120**." 3:41-55. However, Crossen does not state how to make weight 120.

As applicant's representative explained to the examiner, while it is possible to create weight 120 by first forming the outer, less heavy portion (which, though applicant does not concede the point, could be argued to be the claimed receptacle) and then forming the center section 123 next, weight 120 need not necessarily be formed by that process, and could be formed by creating the center section 123 first and then forming the outer ring of 120 around it. If formed in the latter manner, the alleged "receptacle" would not exist before the center section 123, and thus it would be impossible to place the center section 123 into any receptacle.

Crossen's weight 120 does not and cannot meet the claimed receptacle because the outer ring of weight 120 would not **necessarily** have been formed first. Crossen alone, therefore, does not render claims 11 and 12 obvious, and the rejection should be withdrawn.

D. Claims 11 and 12 Are Patentable over Crossen in view of Li.

Claims 11 and 12 stand rejected as obvious over Crossen in view of US 6,446,930 to Li. Crossen does not disclose a receptacle for the reasons provided above. Li also does not disclose a receptacle in which anything can be placed. Rather, Li discloses only a cover that is open to the ground and to which a weight or weights are attached, as shown in Li's figures. Even Li's claims make this clear, reciting "an outer cover having **an open lower end . . .**" Thus, even if it were appropriate to combine the teachings of these two references—and Applicant does not concede this—Li would not cure Crossen's lack of a receptacle. The rejection has been overcome, and should be withdrawn.

E. Claims 11 and 12 Are Patentable over Crossen in view of Li and Bartlett or Faucillon.

The Office states that it rejects claims 11 and 12 as obvious over Crossen in view of Li and US 5,943,814 to Bartlett, Jr. (Bartlett) or US 4,486,973 (Faucillon). However, in the first paragraph of the explanation of the rejection, the Office repeats its contention from prior page 4 that the claimed subject matter is obvious over Crossen and Li. Applicant traverses this aspect of the rejection on the same grounds provided above in section D.

In the next paragraph (the last paragraph on page 5 of the Action), the Office "[a]lternatively" admits that Crossen fails to disclose the claimed receptacle, and states that Bartlett, Jr. discloses a receptacle that the Office identifies as either element number 56 or element number 1. The Office, Applicant believes, intended to reference Faucillon when it identified element number 1. The Office then contends that it would have been obvious to

modify “the method of Crossen such that it has a receptacle and a step of placing pre-formed weighted material in the receptacle in view of Bartlett, Jr. or Faucillon in order to provide a receptacle which can be filled with any weighting material having the desired density as preferred by the user.”

The rejection is overcome for multiple reasons. First, no one of ordinary skill in the art would interpret “pre-formed weighted material” (an example of which is a block (see paragraph [1003] of the present application)) to cover wet, unformed concrete. However, wet concrete is the weighted material disclosed in Bartlett and Faucillon.

Bartlett: Specifically, as explained in the last response, Bartlett discloses pouring wet concrete into mold 56 in order to form runners 14, 16. Furthermore, Bartlett teaches placing wire mesh 18 into the wet concrete so that the wire mesh becomes attached to the concrete runners once they set. See FIGS. 2 and 3 of Bartlett. If pre-formed (*i.e.*, set/dry) concrete were placed into mold 56, this setting of the wire mesh in the runners would not be possible.

Faucillon: The bottom 1 of Faucillon’s trap includes a peripheral channel for holding concrete “or other like ballast may be poured” (col. 1, lines 35-39); the wet concrete is poured into openings 12 and apparently flows through passages in the bridge separators 13 to provide a continuous ring of weighted material. Col. 2, lines 37-41. Furthermore, bottom 1 of Faucillon does not have any protrusions respectively configured to extend through openings in the bottom of the shellfish cage to which it can be hingedly coupled (or that could extend through openings in Crossen’s bait station).

For these reasons, the rejections are overcome and should be withdrawn.

Another reason why the purported combinations of Crossen + Bartlett and Crossen + Faucillon would not render the claimed subject matter obvious is that there is no logical reason –

other than one based exclusively on improper hindsight – to do away with Crossen’s weight 120 and put in its place a receptacle into which pre-formed weighted material could be placed, because, as Crossen explains in his patent, the weight 120 is inventive and important, and its functionality would be lost, resulting in a complete alteration and contravention of Crossen’s device. Applicant’s representative explained this in detail in the March, 2009 email exchange, analyzing and rebutting all the purported motivations supplied by the Office during that exchange. Applicant submits that the Office does not now disagree with Applicant’s logic, having agreed with Applicant in the last exchange on this issue that Crossen was not a suitable reference to modify as the examiner had proposed. Accordingly, this is an additional reason that the rejection is overcome and should be withdrawn.

F. Claims 11 and 12 Are Patentable over Crossen in view of the References Raised by the Examiner During the March, 2009 Email Exchange.

To expedite the prosecution of this application, Applicant sets out the arguments made by the examiner during the March, 2009 email exchange and explains why there is no basis to use those arguments as support for a rejection of the pending claims.

1. Crossen and US 6,637,717

On March 25, 2009, the examiner stated, “Li 6,637,717 discloses a base (20) with pre-formed weighting material (23 filled with sand or stone) which is subsequently placed in the base.” The examiner was apparently suggesting that it would have been obvious to replace Crossen’s weight 120 with Li’s base. **There is no rational basis for such a combination, as required by *KSR*.** See *In re Khan*, 441 F.3d 997, 988 (Fed. Cir. 2006) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.”) (quoted with approval in *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007)).

There is no recognition in Crossen that weight 120 should be varied to the application, or that there is anything wrong with the weight-to-bait station connection. Moreover, Crossen effectively teaches away from changing his weight because he regards the weight as his invention. For example, in the Field of the Invention, he states that the present invention relates to “specially configured weights for securing rodent bait stations.” In the Summary, he states that the invention is the weight: “The invention is a tough, durable rodent bait station weight to anchor a bait station firmly in place” In that same paragraph, he discusses the specifics of the weight itself, including: “The portion of the weight that is directly coupled to the bait station is denser than the remaining portion of the weight. This increased hardness at the point of attachment ensures a strong connection.” Later in the specification, he explains that the weight 120 has a heavier central section 123 that serves as the portion of the weight to which the bait station is anchored. He states, “The solid section 123 centralizes the weight distribution of the weight 120 which vastly improves the anchoring characteristics of the weight 120.” **As the Board has held, it is not obvious to eliminate an aspect of a reference that performs a critical function, like Crossen’s weight 120.** *See Ex parte Farbrot*, Appeal No. 2008-4799, slip op. at 12-14 (BPAI Feb. 24, 2009) (non binding precedent) (reversing an obviousness rejection premised on the replacement of the primary reference’s lotion with the gel of a secondary reference because doing so “would eliminate a critical function” of the primary reference’s product).

Li (6,637,717) has a receptacle into which stone could be placed, but it has no protrusions that would extend up through openings in the bottom of anything (such as a bait station). Instead, Li’s base housing 20 is designed with a chamber 21 into which lower end portion 111 of shaft 11 is simply placed. The shaft can be picked up just as easily – there is nothing that hold

the two together from a vertical perspective besides gravity. There is a spring-loaded foot lever that biases the teeth of an actuator 40 that is mounted in chamber 21 to the rotor 30 of the lower end portion 111 of the shaft, but that is to keep the shaft from rotating (to rotate the shaft, push down on the foot lever and the actuator disengages from the rotor). Thus, even if it were proper to combine Li's base housing 20 with Crossen's bait station—and it is not proper—the resulting apparatus still would not meet “causing the protrusions of the receptacle to extend through the openings in the bottom of the plastic bait station.”

2. Crossen and GB 2249249

On March 25, 2009, the examiner stated, “Also see GB 2249249 to Graves which discloses a weight element (16) rigidly secured or bonded within the base (15), wherein the weight (16) must be formed before it can be bonded or secured to base (15).” The examiner was apparently suggesting that it would have been obvious based on Graves to modify Crossen. **There is no rational basis for modifying Crossen in view of Graves, as required by *KSR*.** See *In re Khan*, 441 F.3d at 988 (Fed. Cir. 2006) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.”) (quoted with approval in *KSR*, 550 U.S. at 418). This follows because of the role weight 120 plays—as explained above—in Crossen's device, and because Graves (GB 2249249) discloses a bait station that includes a weight **inside the station**, not in a separate receptacle (see Figure 1, which shows the weight using hidden lines, and Figure 2, which shows that the weight is inside the cutaway version of the station).

3. Wind or Inclination of Terrain as Reasons to Modify Crossen

On March 25, 2009, the examiner stated, “I still feel strongly that to vary a weight placed within a bait station would have been obvious to one of ordinary skill in the art so as to maintain the bait station in a single location due to varying factors such as wind or inclination of terrain (steepness of a hill for instance). Varying the weight could be dependent upon volume of material or density of material.” The examiner then went on to discuss US 3,708,905; US 3,471,114; US 5,131,184; and US 3,821,861. Applicant addresses the references below. First, Applicant address these purported reasons for modifying Crossen, which fail for reasons in addition to those provided above.

Wind: Crossen specifically addresses wind, and notes that his weight is sufficient: “The rodent bait station weight of the present invention prevents the accidental tipping over a bait station, for example, **by the wind** and the rodent bait station is economical to manufacture.” Col. 4, lines 1-4 (emphasis added). **As the Board has held, a problem that a primary reference has already solved is not one that can support a finding of obviousness.** See *Ex parte Rinkevich*, Appeal No. 2007-1317, slip op. at 8-9 (BPAI May 29, 2007) (noting that “the problem proffered by the Examiner is already solved” by the primary reference, and explaining that “a person of ordinary skill in the art having common sense at the time of the invention would not have reasonably looked at [a secondary reference] to solve a problem already solved by [the primary reference].”).

Terrain: The following explanation is slightly different and more precise than the one Mr. Garrett provided in the email exchange, but the message is the same: terrain is not a suitable reason for modifying Crossen in any way. In the art of weighted bait stations, terrain is not an issue that drives how bait stations are weighted. In general, weighted bait stations are placed on

surfaces that are either flat or nearly flat, so, in such cases, there is no concern of whether the weighted bait station will slide on its own. Furthermore, increasing the mass of pre-formed weighted material placed in a given receptacle on a given surface will not alter the angle at which the receptacle will slip. So, physics undercuts the Office's suggestion that "steepness of a hill" is a logical reason to alter the volume or density of pre-formed weighted material; that would only be true if the coefficient of friction between the receptacle and the surface on which it is placed changes. Moreover, if the examiner has evidence of terrain being an issue at the time of the invention, Applicant will be glad to address it and provide rebuttal declaratory evidence, if appropriate. A specification search of US patents and published applications for ("bait station" and inclin\$ and terrain\$) yielded only one irrelevant published application.

Therefore, neither of these can serve as a rational basis for redesigning Crossen's device. Moreover, Crossen stresses that the his weights are connected at their denser, heavier portion (101 or 123) to the bait station. He explains that doing this "ensures a strong and sturdy mechanical bond with the bait station" (col. 3, lines 6-8) and "vastly improves the anchoring characteristics of the weight 120." (Col. 3, lines 53-55). Changing Crossen so that the bait station is connected to a receptacle in which a weight resides – and eliminating the important connection between the dense/heavy part of his specialized weight and the bait station – would contravene Crossen's intended purpose.

a. Crossen and US 3,708,905

In conjunction with the wind/terrain argument, the examiner also stated on March 25, 2009 that "Jalbert 3,708,905 discloses ballast boxes (100) can be fitted with rock or other suitable ballast which infers that whatever weight necessary to weight the trap will be placed therein." The examiner was apparently suggesting that it would have been obvious to replace

Crossen's weight 120 with Jalbert's ballast box or boxes. **There is no rational basis for such a combination, as required by KSR.** See *In re Khan*, 441 F.3d at 988 (Fed. Cir. 2006) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.”) (quoted with approval in *KSR*, 550 U.S. at 418).

Jalbert I (3,708,905) is not properly combinable with Crossen for the reasons above. In addition, the ballast boxes 100 in Jalbert I do not have protrusions that extend up through holes in the bottom of Jalbert I' trap. Rather, they are attached with angle members 116 to plastic strips 36 secured to the lower side of the bottom frame of the trap. The bolts connecting the angled pieces to the plastic strips terminate in the plastic strips, as shown in FIG. 7. Moreover, Crossen emphasized a weight that is “easy to attach and remove” (col. 2, lines 16-17) and “economical to manufacture” (col. 4, lines 3-4). Jalbert I's ballast boxes – with the multiple angled pieces and strips and connectors – are too complex to comport with either of these objectives.

b. Crossen and US 3,471,114

In conjunction with the wind/terrain argument, the examiner also stated on March 25, 2009 that “Ball 3,471,114 discloses the use of either sand or water as ballast, both of which have different densities and thus would provide different weight amounts.” The examiner was apparently suggesting that it would have been obvious to replace Crossen's weight 120 with Ball's ballast base. **There is no rational basis for such a combination, as required by KSR.** See *In re Khan*, 441 F.3d at 988 (Fed. Cir. 2006) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning

with some rational underpinning to support the legal conclusion of obviousness.”) (quoted with approval in *KSR*, 550 U.S. at 418).

Ball (3,471,114) is not properly combinable with Crossen for the reasons above. Ball has other shortcomings as well. The weights (sand/water) are not pre-formed, and Ball is specifically designed for liquid given the threaded plug 28. Additionally, the ballast base does not have protrusions that extend through holes in the bottom of the garbage can.

c. Crossen and US 3,821,861

In conjunction with the wind/terrain argument, the examiner also stated on March 25, 2009 that “Jalbert 3,821,861 discloses slab weights (44) which can be interchanged to provide the correct weight required for the waters being worked (see col. 3, lines 58-60).” The examiner was apparently suggesting that it would have been obvious based on Jalbert ‘861 to modify Crossen. **There is no rational basis for modifying Crossen in view of Jalbert ‘861, as required by *KSR*.** See *In re Khan*, 441 F.3d at 988 (Fed. Cir. 2006) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.”) (quoted with approval in *KSR*, 550 U.S. at 418). The weights in Jalbert II (3,821,861) are placed in the trap itself, not in a separate receptacle that is secured to the trap.

d. Crossen and US 5,131,184

In conjunction with the wind/terrain argument, the examiner also stated on March 25, 2009 that “Harrison 5,131,184 discloses a trap with a weight (28) that may vary between 25-35 weight range.” The examiner was apparently suggesting that it would have been obvious based on Harrison to modify Crossen. **There is no rational basis for modifying Crossen in view of Harrison, as required by *KSR*.** See *In re Khan*, 441 F.3d at 988 (Fed. Cir. 2006) (“[R]ejections

on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.”) (quoted with approval in *KSR*, 550 U.S. at 418). The weight in Harrison (5,131,184) is not in a receptacle. It is bolted to the trap, much like Crossen’s, but in an entirely different setting (minnow trap in water).

4. Crossen and US 3,343,744

On March 30, 2009, the examiner stated: “Also see Morell et al. 3,343,744 which is a bait box for holding poisoning rodents comprising a box with triangular compartments A which are adapted to be filled with sand, gravel or the like so as to provide the necessary weight to prevent the set-up box from being moved either by wind or by an animal seeking the bait which is placed within compartment B, wherein it can be interpreted that sand and gravel are pre-formed by mother nature.” The examiner then stated, “I am trying to show that it would have been obvious to modify Crossen (sic) with Morell or any of the other devices which show the addition of weights to a portion below the receptacle to provide a user adjusted ballast.”

There is no rational basis for modifying Crossen as suggested by the examiner, for the reasons provided above. See *In re Khan*, 441 F.3d at 988 (Fed. Cir. 2006) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.”) (quoted with approval in *KSR*, 550 U.S. at 418). Morell’s compartments are inside the bait station, not secured to them with protrusions that extend up through the bottom of the bait station. In fact, the claimed configuration is the antithesis of Morell’s foldable construction. This is clear from reviewing the first column of Morell’s patent. In short, Morell

does not anticipate or render the claims obvious, nor would there be any logical reason to combine it with Crossen.

G. General Shortcomings of the Office's Approach: The Office Must Consider the Content of the Reference It Modifies and Must Take into Account the Graham Factors To Establish a *Prima Facie* Case of Obviousness.

The claimed subject matter is not obvious. However, should the Office make another attempt to claim otherwise, Applicant points out that the Office must take into account the teachings of the reference it seeks to modify. As the Board has explained, "the relative advantages of each reference must be considered when considering the obviousness of a claim." *Ex parte Farbroth*, slip op. at 13. See also MPEP 2143.01 V. "THE PROPOSED MODIFICATION CANNOT RENDER **THE PRIOR ART** UNSUITABLE FOR ITS INTENDED PURPOSE" and VI. "THE PROPOSED MODIFICATION CANNOT CHANGE THE PRINCIPLE OF OPERATION OF A **REFERENCE**." In addition, the Office must make *Graham* factor findings. The failure to take these steps will expose the rejection to reversal on appeal, and unnecessarily extend the length of prosecution of the application.

H. Conclusion

Claims 11 and 12 are in condition for allowance. The Examiner is invited to contact Applicant's attorney with any questions or comments relating to this application.

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